

APPLICANT(S): Heilper et al.
SERIAL NO.: 10/813,459
FILED: March 30, 2004
Page 7

REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Status of Claims

Claims 1 - 5, 11 - 17 and 22 - 26 are pending in the application. Claims 1 - 5, 11 - 17 and 22 - 26 have been rejected. Claims 11, 13, 22, and 26 have been amended.

Claims 1 - 5, 14 - 17 and 23 - 24 have been canceled without prejudice or disclaimer. In making this cancellation without prejudice, Applicants reserve all rights in these claims to file divisional and/or continuation patent applications.

New claims 27 - 29 have been added in order to further define what the Applicants consider to be the invention. Applicants respectfully assert that no new matter has been added.

Applicants respectfully assert that the amendments to the claims and specification add no new matter.

Remarks to the Specification

The amendments to the specification are editorial in nature and do not introduce new matter.

CLAIM REJECTIONS

35 U.S.C. § 102 Rejections

APPLICANT(S): Heilper et al.
SERIAL NO.: 10/813,459
FILED: March 30, 2004
Page 8

In the Office Action, the Examiner rejected claims 1 - 5, 11 - 17 and 22 - 26 under 35 U.S.C. § 102b, as being anticipated by Cohen (US 2003/0050891).

Claims 1 - 5, 14 - 17 and 23 - 24 have been cancelled and therefore, the Examiner's rejection of these claims is now moot.

Regarding the Examiner's rejection of claims 11 - 13, 22 and 25 - 26, Applicants respectfully traverse this rejection in view of the remarks that follow.

Cohen discloses "a system and method for the registration and tracking of items through a database" (Abstract, lines 1-2) using tracking checks, on which tracking numbers are recorded. The numbers are:

"based on the combination of ABA routing numbers and bank-added numerical fields, or other similar tracking systems recognized by financial institutions. The tracking numbers are used to identify items of personal property to establish and maintain a chain of title and possession, and to register and track the title and possession of such items through a database. As used herein, the term "item" refers to a piece of personal property or a document in tangible form. For example, an item can be a limited edition art print, a sports collectable item, a wristwatch, a movie script, etc." (Para. [0034], lines 2-12)

According to Cohen, tracking checks can have associated bar codes, and adhesive labels on which the bar code is printed that can be attached to the item associated with the tracking check. Alternatively, the tracking check itself can be attached to the item (Paras. [0036], [0042]). The tracking number is stored in a database and "the database uses the tracking number to identify the item, its titleholder, and its chain of possession and ownership (Para. [0045], lines 20 - 21).

Amended claim 11 on the other hand, now recites:

"A counterfeit detection method comprising:
reading a label attached to a manufactured item, said label incorporating a manufacturer-controlled identification number;

APPLICANT(S): Heilper et al.
SERIAL NO.: 10/813,459
FILED: March 30, 2004
Page 9

querying a third party authority to verify that said item is a genuine product of its indicated manufacturer; and
generating a certificate of authenticity to provide to a purchaser of said item if said querying yields an affirmative result."

The labeled items in Cohen are not "genuine products of its indicated manufacturer" but rather pieces "of personal property or a document in tangible form. For example, an item can be a limited edition art print, a sports collectable item, a wristwatch, a movie script, etc." (Para. [0034] lines (9 - 12)). In Cohen, the items are not connected to the manufacturer but to the owner or previous owner, nor are their identification numbers "manufacturer-controlled."

As a result, Cohen does not "verify that a manufactured item is a genuine product of its indicated manufacturer" by "querying a third party authority". Cohen's method includes querying the administrator of the "database" regarding an item but only to "identify the item, its titleholder, and its chain of possession and ownership" (Para.[0045] line 20 – 21).

Moreover, Cohen's method cannot be used verify that the "item is a genuine product of its indicated manufacturer" because his method does not have any provisions for the differentiation, on the basis of label data, between a genuine product of a manufacturer and a counterfeit product.

A similar argument holds for independent claim 22 which now recites:

"A point of sale unit comprising:
a reader to read a label attached to a manufactured item, said label incorporating a manufacturer-controlled identification number;
a verifier to query a third party authority to verify that said item is a genuine product of its indicated manufacturer; and
a printer to generate a certificate of authenticity if said query yields an affirmative result."

APPLICANT(S): Heilper et al.
SERIAL NO.: 10/813,459
FILED: March 30, 2004
Page 10

Cohen's method does not happen at the point of sale, nor can it be used to verify that the "item is a genuine product of its indicated manufacturer" because his method, once again, does not have any provisions for the differentiation, on the basis of label data, between a genuine product of a manufacturer and a counterfeit product.

With respect to new claim 29 and as discussed hereinabove, Cohen does not, *inter alia*, maintain

"a database cataloguing the following:

manufactured items identified by manufacturer-controlled identification numbers; and

commercial entities between which said items are transferred from manufacture until point of sale"

Accordingly, Applicants respectfully assert that amended independent claims 11 and 22 and new independent claim 29 are allowable. Claims 12 – 13 and 25 – 26 and new claims 27 and 28 depend from, directly or indirectly, claims 11 and 22, and therefore include all the limitations of those claims. Therefore, Applicants respectfully assert that claims 12 – 13 and 25 – 28 are likewise allowable. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections to amended claims 11 – 13, 22 and 25 – 26.

In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

APPLICANT(S): Heilper et al.
SERIAL NO.: 10/813,459
FILED: March 30, 2004
Page 11

Please charge any fees associated with this paper to deposit account No. 09-0468.

Respectfully submitted,

By: 
Stephen C. Kaufman
Reg. No. 29,551
Phone No. (914) 945-3197

Dated: December 8, 2005

IBM Corporation
Intellectual Property Law Dept.
P. O. Box 218
Yorktown Heights, New York 10598